

## Remarks

### Rejection of Claims under 35 USC 102

Claims 1-3, 6 and 8 stand rejected as anticipated by DE 196 50 942.

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

Claims 1-3, 6 and 8 stand rejected as being unpatentable over DE 196 50 942 in view of Okura et al (Okura).

Claims 1, 2 and 5-9 stand rejected as being unpatentable over the combined teachings of Shirota and Quass.

Claims 1 and 5-9 stand rejected as being unpatentable over the combined teachings of Takagi and Quass.

Claims 1, 5 and 8 stand rejected as being anticipated by DE 4014501.

Neither DE 196 50 942 A1 nor DE 4014501 disclose or teach each feature of the rejected claims.

We submit a set of new claims 10 to 17 to use as the basis for further examination. In this set of new claims 10 to 17. Claims 10 to 16 also were filed at the German Patent and Trademark office and have been accepted by the Examiner. In particular it is to be noted that claim 10 is based on a combination of originally filed claims 1 to 3. Such a combination is not anticipated by DE 196 50 942 A1 or DE 4014501. It is obvious that the system as disclosed in this prior art provides no support arrangement with a closure region as defined in the "wherein" portion of new claim 10.

### Rejections of Claims under 35 USC 103(a)

Claims 1-3, 6 and 8 stand rejected as obvious over DE 196 509 42.

To establish a *prima facie* case of obviousness under 35 USC 103(a) the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implyingly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” (MPEP 706.02(j))

MPEP 706.02(j) confirms the relevant case law on this subject.

“Valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the claimed invention. US Court of Appeals for the Federal Circuit (*Ecolochem inc. v Southern California Edison Co., Fed. Cir.*, No. 99/1043, 9/7/00).

The best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for showing a teaching or motivation to combine the prior art references, according to the court.”

Court of Appeals for the Federal Circuit confirmed the above principles in *In Re Sang-Su Lee* (00-1158). The court analyzed 35 USC 103 requirements starting from the Administrative Procedure Act and held (citations omitted):

“Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies.

“The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of “reasoned decision making.” Not only must an agency’s decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

“As applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that rejections under 35 USC §103 must be based on evidence comprehended by the language of that section. (Emphasis added). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” (Emphasis added)

“The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so.”

**DE 196 50 942 A1 or DE 4014501 do not motivate or suggest to a person skilled in the art to combine these references to duplicate the claims of the present invention.**


The inadequacies of teachings of these primary references are discussed above.

Allowable Subject Matter

The new set of claims submitted herewith contains a second independent claim 17 which the Examiner indicated would be allowable. New claim 17 is a combination of originally filed claims 1 and 4 and addresses the "112" objection raised by the Examiner.

Wherefore further consideration and allowance of the claims as set forth in this Amendment is hereby requested.

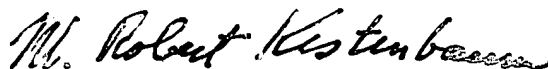
Respectfully submitted,



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